

### **REMARKS**

New claim 15 is added. Support for the new claim is provided by the originally-filed application at, for example, paragraph 0027-0030. New claim 16 is added. Support for the new claim is provided by the originally-filed application at, for example, paragraph 0026.

The finality of the present office action is premature, and therefore, pursuant to MPEP §706.07(d) (8<sup>th</sup> ed., rev. 5), Applicant requests reconsideration and withdrawal of the premature finality of the present office action. Claim 14 is not addressed by the present office action. Claim 14 recites "wherein the separation-into-single-grains step comprises: ejecting **water** toward rice grains; providing the rice grains in a screen; and ejecting air toward the screen." The Examiner relies on Matthews of a combination of references to allegedly teach two limitations of claim 14, that is, "providing the rice grains in a screen; and ejecting air toward the screen" (see rejections against dependent claims 11-13). However, the Examiner fails to address "ejecting **water** toward rice grains" of the separation-into-single-grains step. Moreover, an electronic search of Matthews verifies that such reference fails to teach this limitation.

MPEP §706.07 (8<sup>th</sup> ed., rev. 5) states that "the examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal." (Emphasis added). MPEP §706.07 further states that "present practice does not sanction hasty and ill-considered **final** rejections. The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application." Final rejections "must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal."

Presently, the record for appeal is poor due to the deficiencies of the current Office Action wherein Applicant is unsure if claim 14 is rejected or allowed and the Examiner had an opportunity to determine before the finality of the present action. The Examiner's Action fails to follow the enumerated requirements of MPEP §706.07, and therefore, a withdrawal of the premature final action is appropriate and Applicant requests same.

Claims 1-5 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner states the phrase "at least surface layers" recited in independent claim 1 renders the claim indefinite. Applicant has amended claim 1 to delete the phrase "at least." Furthermore, Applicant has added language to overcome concern the Examiner had with the degree of rice grains being converted. Support for the amendment language to claim 1 is provided at paragraph 0027 of the application. Accordingly, Applicant has addressed and overcome the issues raised by the Examiner regarding the phrase "at least surface layers" recited in independent claim 1. Applicant respectfully requests withdrawal of the §112 rejection in the next action.

Additionally under the §112 second paragraph rejection, the Examiner states independent claim 1 omits essential steps directed to the positively recited alpha-type conversion step. The Examiner bases this contention on an alleged deficiency in the specification stating: "the specification describes this process as cooking or steaming (page 6), however no clear limitations are designed." (previous office action at page 3 of paper no. 20060420, incorporated by reference in current action). Respectfully, the Examiner is mistaken. Paragraph 0027 at pages 21 and 22 of the originally-filed

application provides extensive support for the positively recited alpha-type conversion step. Consequently, this rejection is inappropriate and should be withdrawn.

Claims 1-10 are rejected under 35 U.S.C. §103(a) as being unpatentable over Lewis, et al. (U.S. Patent No. 5,275,836) in view of the combination of Walton (<http://waltonfeed.com/self/rice.html>) and Ogawn (Japan Patent No. JP 92006330B – abstract only). Claims 11-13 are rejected under 35 U.S.C. §103(a) as being unpatentable over Lewis, et al. (5,275,836) in view of the combination of Walton and Ogawn, further in view of Mathews (U.S. Patent No. 3,759,380).

Regarding the rejection against independent claim 1, claim 1 is amended to recite wherein the converting of the surface layers comprises *about 60% to 90% of the rice grains being converted* to the **alpha-structure type**. The art of record, singularly or in any combination, fails to teach or suggest **any percentage** of rice grains being converted to an alpha-structure type. Accordingly, it is inconceivable that the art of record can be reasonably or fairly stated to teach or suggest “wherein the converting of the surface layers comprises *about 60% to 90% of the rice grains being converted* to the **alpha-structure type**” as positively recited by claim 1. Since all elements must be shown to be suggested by the prior art when making a rejection based upon obviousness under 35 U.S.C. §103(a) (*see In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1987)), and the prior art fails to teach all the recited elements of claim 1, independent claim 1 is allowable.

Further regarding the obviousness rejection against claim 1, the U.S. Supreme Court recently addressed the requirements of the Examiner when providing an appropriate obviousness rejection. The court stated that the analysis supporting a rejection under 35 U.S.C. §103(a) should be made explicit, and that it was “important to identify a reason that

would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. The Court specifically stated:

Often, it will be necessary...to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an **apparent reason** to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis **should be made explicit**.

*KSR International Co. v. Teleflex Inc.* (550 U.S. \_\_\_, No. 04-1350, decided April 30, 2007) (emphasis added).

The obviousness rejection against claim 1 is based on a combination of art that includes Ogawn. Ogawn is presented to teach numerous limitations of claim 1 not taught by the primary reference to Lewis. However, the entire disclosure of Ogawn is one paragraph under an Abstract heading and less than two sentences under an Use/Advantage heading. The motivational rationale for which the Examiner relies upon to combine Ogawn with Lewis is based on the less than two sentences under the Use/Advantage heading. However, this rationale of an “advantage” taught by Ogawn is directed to the method steps of Ogawn. That is, the advantage taught by Ogawn can only reasonably be stated to be applicable to the method steps of Ogawn. There is absolutely no teaching that the method steps of Ogawn are compatible with the method steps of Lewis. Logically, there is no teaching that the advantages of Ogawn are compatible or would be realized if the method steps of Ogawn are combined with the method steps of Lewis. The Examiner cannot assume that because the method steps of Ogawn deal with rice that advantages of Ogawn are compatible with the method steps of Lewis which also

deals with rice. An assumption is inapposite to a teaching, and a teaching is required for a proper obviousness rejection.

In fact, independent claim 1 is directed to instant rice where one skilled in the art understands such instant rice can be prepared for consumption by adding boiling water. However, one skilled in the art would also understand that Lewis is not directed to instant rich. Moreover, the cited methods steps of Ogawn begin with polished rice wherein the invention of claim 1 is directed to, initially, brown rice. Brown rice and white rice do not react to the same processing steps in the same matter. One method step for brown rice can be beneficial while the same method step for white rice could have no effect, or worse, be detrimental. Accordingly, the methods step and advantage teachings relied upon by the Examiner from one reference is not applicable another reference with teachings to such compatibility. The Examiner has failed to identify an appropriate reason based on teachings that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed pursuant to the recent U.S. Supreme Court. The combination of art relied upon to reject claim 1 is inappropriately combined, and therefore, the obviousness rejection fails and should be withdrawn.

Independent claim 1 is allowable.

Claims 2-16 depend from independent claim 1, and therefore, are allowable for depending from an allowable independent claim.

For example, claim 2 recites “further comprising a water-removing step between said primary immersing step and said primary alpha-type conversion step.” The Examiner relies on Lewis to teach the recited **primary** steps (and for clarity sake, the Examiner relies on Ogawn to allegedly teach the recited secondary steps recited in claims 1 and 3).

However, the Examiner points to no teachings of Lewis directed to a **water-removing step between** said primary immersing step and said primary alpha-type conversion step as recited by claim 2. Consequently, claim 2 is allowable for this additional reason.

Additionally, claim 6 recites “wherein the milling step comprises milling using a **vertical-type** polishing machine.” The Examiner states Lewis’s teaching to a horizontal milling machine is equivalent to a vertical-type polishing machine. The Examiner is mistaken. One skilled in the art understands that a vertical-type polishing machine is not equivalent to a horizontal-type machine. The very reason that there are two types of machines is that each has its advantages and disadvantages. One consideration is the fact that one relies on gravity in a completely different manner than the other. This basic concept of difference demonstrates that the Examiner’s equivalency rationale is improper, and therefore, the obviousness rejection against claim 6 is improper and should be withdrawn.

Dependent claim 7 is amended to recite the primary immersing step comprises using an apparatus that is substantially different structurally from an apparatus utilized in the secondary immersing step. The amendment language is supported by the figures of the originally-filed application. The amendment language renders ineffective the Examiner’s motivational rationale for modifying the Lewis method to allegedly teach the positively recited limitations of the original language of claim 7. Therefore, claim 7 is now in allowable form.

New claim 15 recites “wherein the secondary alpha-type conversion step comprises converting core portions of the rice grains to the alpha-structure type, and wherein the secondary immersing step comprises providing the moisture content of the rice

grains to a range of about 55% to 60%.” Lewis teaches moisture content of 20% to 40%. However, this level of moisture content would make it impossible to perform the conversion step wherein “core portions of the rice grains [are converted] to the alpha-structure type” as positively recited by claim 15. Accordingly, the primary reference to Lewis does not teach, and could not be appropriately modified, to teach the positively recited limitations of claim 15. Claim 15 is allowable.

Additionally, the combination of references to allegedly teach the limitations of claims 11-13 includes Matthews where Matthews is used to teach the separation-into-single-grains step. However, Matthew is directed to a “combine” (abstract) which is used in a field in dry weather. One skilled in the art understands that a combine, and the apparatus and methods used therein, would not be capable of separating rice into single grains. Accordingly, there is no reasonable rationale for using the Matthews reference to teach such limitations of claims 11-13. The obviousness rejection against claim 11-13 fails and claims 11-13 are allowable for this additional reason.

This application is now believed to be in immediate condition for allowance, and action to that end is respectfully requested. If the Examiner’s next anticipated action is to be anything other than a Notice of Allowance, the undersigned respectfully requests a telephone interview prior to issuance of any such subsequent action.

Respectfully submitted,

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